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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 694,074	10/20/2000	Rebecca J. Jackman	H0498.7085 TJO	2002

7590 08/13/2002

Timothy J. Oyer  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, MA 02210

EXAMINER

WATKINS III, WILLIAM P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/13/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/694,074

Applicant(s)

JACKMAN ET AL.

Examiner

William P. Watkins III

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-90 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Applicant's response, filed 07 May 2002 to the restriction mailed 26 February 2002 as paper No. 6, has been noted, but is moot in view of the new revised restriction requirement given below based upon further review and consultation.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-66, 83-90, drawn to a method of coating an article using a mask, classified in class 427, subclass 282.

II. Claims 67-82, drawn to an elastomeric mask, classified in class 428, subclass 131.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group II, claims 67-82 and Group I, claims 1-66, 83-90 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used in a different process such as filtration of a solid from a liquid.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and since the fields of search are not co-extensive, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

A) a method using an electrochemical deposition agent (claim 40), claims 1-33, 50-62, 64-66, 42, 36 and 83-90 are generic to this species;

B) a method using an electroless deposition agent (claim 41), claims 1-33, 50-62, 64-66, 42, 36 and 83-90 are generic to this species;

C) a method using an agent that is an etchant (claims 48 and 49), claims 1-33, 51-62, 66, 42 and 36 are generic to this species;

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D) a method of using a fluid precursor as an agent from which an inorganic agent hardens (claim 43), claims 1-33, 50-62, 64-66, 42, 36 and 83-90 are generic to this species;

E) a method of using a fluid precursor as an agent from which particles are deposited (claim 44), claims 1-33, 51-62, 66, 42 and 36 are generic to this species;

F) a method of using a fluid precursor as an agent with a chemically active agent where said active agent is capable of promoting deposition of a material (claim 47), claims 1-33, 51-62, 66, 42, 45 and 36 are generic to this species;

G) a method of using a fluid precursor as an agent with a chemically active agent where said active agent is a prepolymeric species (claim 46), claims 1-33, 50-62, 64-66, 42, 36, 45 and 83-90 are generic to this species;

H) a method of using CVD as an agent (claim 37), claims 1-33, 50-62, 64-66, 38 and 83-90 are generic to this species;

I) a method of using e-beam deposition as an agent (claim 39), claims 1-33, 50-62, 64-66, 38 and 83-90 are generic to this species;

J) a method of using sputtering as an agent (claim 39), claims 1-33, 50-62, 64-66, 38 and 83-90 are generic to this species;

K) a method of using an organic electroluminescent material as an agent (claims 34-35 and 63, the electroluminescent material is disclosed in the specification as being deposited by evaporation), claims 1-33, 50-62, 64-66, 38, 39 and 83-90 are generic to this species.

Applicant is required, if the method group is elected, under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the claims noted above are generic to the particular noted species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37

CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was not made to request an oral election to the above restriction requirement in view of a written restriction being requested in parent case 09/063,742 and the complexity of the above requirement. Applicant is required to elect between the method and article groups, and if the method group is elected, further elect a species to be examined.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 703-308-2420. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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August 11, 2002

A handwritten signature in cursive script, appearing to read "William P. Watkins III".

WILLIAM P. WATKINS III  
PRIMARY EXAMINER